

REMARKS

Reconsideration and withdrawal of all grounds of rejection are respectfully requested in light of the above amendments and the following remarks. Claims 1-8, as amended, remain pending herein.

Summary of the Rejections:

(1) Claims 1-3 stand rejected under 35 U.S.C. §103(a) as allegedly being obvious over Lantz (U.S. 5,258,334).

(2) Claim 4 stands rejected under 35 U.S.C. §103(a) as allegedly being obvious in view of Lantz as applied to claim 1, and further in view of DiBugnara (U.S. 4,243,427).

(3) Claim 5 stands rejected under 35 U.S.C. §103(a) as allegedly being obvious over Lantz and DiBugnara, and further in view of Bearinger et al. (U.S. 6,144,106 hereafter "Bearinger").

(4) Claims 6 and 7 stand rejected under 35 U.S.C. §103(a) as allegedly being obvious over Lantz as applied to claim 1 above, and further in view of Gilberg et al. (U.S. 5,053,992 hereafter "Gilberg").

(5) Claim 8 stands rejected under 35 U.S.C. §103(a) as allegedly being obvious over Lantz in view of Gilberg, and further in view of Stafford et al. (U.S. 5,892,661 hereafter "Stafford").

Applicants' Traversal:

Claim 1 has been amended to recite, *inter alia*, that and the coating comprises a second powdery filler which is a substantial absorber of radiation **and transforms radiation into heat and is present of sufficient quantity to absorb at least 99% of infrared radiation in contact therewith** (specification page 2, lines 9-11).

The presently claimed invention thus provides a way to scatter visible light and absorb near-infrared light, as prior art systems allowed approximately 10% of the near-infrared light to pass. Security in items such as smartcards can be compromised if such a large amount of near-infrared light is allowed to pass.

While the Lantz reference may disclose two types of powders, it is respectfully submitted that the reference fails to disclose or suggest the problem of near infrared being used to compromise security in addition to visible light, and the reference fails to provide any teaching, disclosure, or motivation regarding a percentage of near-infrared light that could be permissible, and where a increase over such a limit could allow security to be compromised.

It is the present invention, and not the Lantz reference (or any in combination therewith) that teaches the use of a first powder for scattering visible light and a second powder for transforming infrared radiation into heat that are provided in such quantities that 99% of the infrared radiation (preferably 99.9%) is absorbed.

As Lantz, and/or any of the combinations of Lantz and DiBugnara, and/or further in view of Bearinger, or Lantz and Gilberg, or Lantz in view of Gilberg, and further in view of Stafford fails to teach how much infrared radiation should be blocked, it is respectfully submitted that none of the instant claims would have been obvious to an artisan because

Lantz (and or any combination therewith) might have a sufficient degree of particles of a second filler to absorb 99% of the near infrared light. This teaching comes from Applicant's claims, and not from anything gleaned by an artisan from the combination of teachings of the references.

Accordingly, it is respectfully submitted that all grounds of rejection under 35 U.S.C. §103(a) are overcome.

Applicants respectfully submit that it was held by *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) that in order to establish a *prima facie* case of obviousness, three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings.

Second, there must be a reasonable expectation of success.

Third, the prior art reference must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, and not based on Applicant's disclosure.

In the present case, there is no teaching, or motivation provided regarding utilizing a second filler in a sufficient quantity such that 99% of near-infrared radiation is absorbed and transformed into heat. Reconsideration and withdrawal of this ground of rejection are respectfully requested.

Applicants also respectfully submit that dependent claims 2-7 are allowable at least for their dependence upon base claim 1, which is believed to be allowable, and because of an independent basis for patentability.

Amendment
Serial No. 09/730,656


Docket No. PHN 17,812

For all the foregoing reasons, it is respectfully submitted that all the present claims are patentable in view of the cited references. A Notice of Allowance is respectfully requested.

Respectfully submitted,

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